



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,888	11/08/2001	John Ruckart	36968/262330 (BS 001250)	5266

23552 7590 09/29/2003

MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

EXAMINER

TRAN, QUOC DUC

ART UNIT	PAPER NUMBER
----------	--------------

2643

DATE MAILED: 09/29/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Am

Office Action Summary

Application No.

10/008,888

Applicant(s)

RUCKART ET AL.

Examiner

Quoc D Tran

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of copending Application No. 10/008,511. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-16 of instance application is similar in scope to claims 1-37 of application 10/008,511 with obvious wording variations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

Art Unit: 2643

subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 6-8, 10-12 and 15-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Lesley (6,188,752).

Consider claim 1, Lesley teaches a method for prepaid communications, comprising: crediting a user account with prepaid credit; detecting a predefined condition associated with a communications connection and deducting the cost of the communications connection from the user account, wherein the predefined condition comprises origination of the communications connection from one of a plurality of predefined sources (abstract; col. 2 lines 14-29, lines 65-67; col. 4 lines 32-48; col. 5 lines 51-58; col. 6 lines 4-42).

Consider claim 2, Lesley teaches the method wherein the communications connection comprises a phone call (col. 4 lines 32-48).

Consider claim 3, Lesley teaches the method wherein the communications connection comprises a digital subscription line ("DSL") (col. 4 lines 32-48).

Consider claim 4, Lesley teaches the method wherein the communications connection comprises an Ethernet connection (col. 4 lines 32-48).

Consider claim 6, Lesley teaches the method wherein the predefined condition further comprises an access code (col. 6 lines 60-64).

Consider claim 7, Lesley teaches the method further comprising notifying a user of the amount of the prepaid credit (col. 10 lines 19-22).

Consider claim 8, Lesley teaches the method wherein the predefined condition further comprises a determination that the communications connection is a long distance call (abstract).

Consider claim 10, Lesley teaches the method further comprising accepting a code number to access the user account (col. 9 lines 45-63).

Consider claim 11, Lesley teaches the method further comprising terminating the communications connection if the predefined condition is not met (col. 8 lines 22-25). It should be noted that the system would inherently terminate the call if no further action being taken.

Consider claim 15, Lesley teaches a computer readable medium for prepaid communications, comprising: a first set of instructions for crediting a user account with prepaid credit associated therewith; a second set of instructions for deducting the cost of a communications connection from the credit in the user account if a predefined condition associated with the communications connection is detected; and wherein the predefined condition comprises the origination of the communications connection originating from a predefined source (abstract; col. 2 lines 14-29, lines 65-67; col. 4 lines 32-48; col. 5 lines 51-58; col. 6 lines 4-42).

Consider claim 12, Lesley teaches a method for prepaid wireline, comprising: crediting a first user account with a first prepaid credit amount, wherein the first user account comprises a first access code; crediting a second user account with a second prepaid credit amount, wherein the second user account comprises a second access code; receiving a proffered code and an origination of a communications connection; if the origination of the call is a predefined source and the proffered code comprising the first access code, deducting the cost of the communications connection from the first prepaid credit amount; and if the origination of the communications connection is the predefined source and the code comprising the second access code, deducting the cost of the communications connection from the second prepaid credit

Art Unit: 2643

amount (abstract; col. 2 lines 14-29, lines 65-67; col. 4 lines 32-48; col. 5 lines 51-58; col. 6 lines 4-42). It should be noted that each database record is associated with each subscriber account that include a separate PIN or access code. Thus, the system must deduct the cost for the communication from the account associated with the PIN accordingly.

Consider claim 14, Lesley teaches the method further comprising deducting the cost of the communications connection from at least one of the first user account or second user account if the communications connection is long distance (abstract).

Consider claim 16, Lesley teaches a computer readable medium for prepaid communications, comprising: a first set of instructions for crediting a first user account with a first prepaid credit amount, wherein the first user account includes a first access code; a second set of instructions for a second set of instructions for crediting a second user account with a second prepaid credit amount, wherein the second user account includes a second access code; a third set of instructions for detecting a code and origination of a communications connection; a fourth set of instructions for deducting the cost of the communications connection from the first prepaid credit amount if the origination line of a phone call is a predefined source; and a fifth set of instructions for deducting the cost of the communications connection from the second prepaid credit amount if the origination of a call is the predefined source and the code is the second access code (abstract; col. 2 lines 14-29, lines 65-67; col. 4 lines 32-48; col. 5 lines 51-58; col. 6 lines 4-42). It should be noted that each database record is associated with each subscriber account that include a separate PIN or access code. Thus, the system must deduct the cost for the communication from the account associated with the PIN accordingly.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5, 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lesley (6,188,752) in view of Jones et al (6,195,422).

Consider 5, Lesley did not further suggest wherein the predefined condition further comprises a destination number of the communications connection. However, Jones et al teach a pre-paid telecommunication services that provided restriction to a particular destination (col. 6 lines 10-36). Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to utilize the teaching of Jones et al into view of Lesley in order to provide user to the flexibility of controlling their usages.

Consider claim 9, Lesley did not further suggest further comprising bypassing toll restrictions if a bypass code is received. However, Jones et al teach a pre-paid telecommunication services that provided restriction to a particular destination wherein toll restriction may be bypassed (col. 6 lines 10-36; col. 15 lines 20-25). Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to utilize the teaching of Jones et al into view of Lesley in order to provide user to the flexibility of controlling their usages.

Consider claim 13, Lesley did not further suggest further comprising bypassing toll restrictions if a bypass code is received. However, Jones et al teach a pre-paid

Art Unit: 2643

telecommunication services that provided restriction to a particular destination wherein toll restriction may be bypassed (col. 6 lines 10-36; col. 15 lines 20-25). Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to utilize the teaching of Jones et al into view of Lesley in order to provide user to the flexibility of controlling their usages.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
8. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

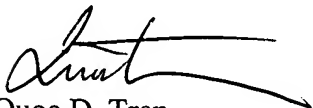
Facsimile responses should be faxed to:
(703) 872-9314

Hand-delivered responses should be brought to:
Crystal Park II, 2121 Crystal Drive
Arlington, VA., Sixth Floor (Receptionist)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Quoc Tran** whose telephone number is **(703) 306-5643**. The examiner can normally be reached on Monday-Thursday from 8:00 to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Curtis Kuntz**, can be reached on **(703) 305-4708**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Technology Center 2600** whose telephone number is **(703) 306-0377**.



Quoc D. Tran
Patent Examiner AU 2643
September 21, 2003